

## REMARKS

In the Office Action dated September 8, 2003, the Examiner objected to the abstract under 35 U.S.C. § 111 as exceeding the maximum allowable limit; objected to the disclosure because of certain informalities; objected to the drawings because of a typographical error in Figure 13; and objected to claim 7 because of an informality. Further, the Examiner rejected claims 1-6, 11-16, 21-26, 31-36, 41-46, 51-56, 61-66, and 71-76 under 35 U.S.C. § 102(b) as being anticipated by Templin et al. (U.S. Patent No. 5,781,550); rejected claims 7, 9-10, 17, 19-20, 27, 29-30, 37, 39-40, 47, 49-50, 7, 9-10, 17, 19-20, 27, 29-30, 37, 39-40, 47, 49-50, 57, 59-60, 67, 69-70, 77, and 79-80 under 35 U.S.C. §103(a) as unpatentable over Templin et al. as applied to claims 1-6, 11-16, 21-26, 31-36, 41-46, 51-56, 61-66, and 71-76, and further in view of Aviani, Jr. et al. (U.S. Patent No. 6,532,493); and rejected claims 8, 18, 28, 38, 48, 58, 68, and 78 under 35 U.S.C. § 103(a) as being unpatentable over Templin et al. as applied to claims 1-6, 11-16, 21-26, 31-36, 41-46, 51-56, 61-66, and 71-76, in view of Aviani, Jr. et al. as applied to claims 7, 9-10, 17, 19-20, 27, 29-30, 37, 39-40, 47, 49-50, 7, 9-10, 17, 19-20, 27, 29-30, 37, 39-40, 47, 49-50, 57, 59-60, 67, 69-70, 77, and 79-80, and further in view of Coile et al. (U.S. Patent No. 6,473,406).

By this amendment Applicants have amended the abstract, the specification, and the drawings. A replacement abstract has been provided that satisfies the length restrictions of 35 U.S.C. § 111. Further, the specification has been amended to correct the informalities identified by the Examiner and to correct other minor grammatical and typographical errors. Moreover, a replacement drawing sheet has been provided for Figure 13, and the figure has been amended to correct the typographical error identified by the Examiner.

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Additionally, by this Amendment, Applicants have canceled claims 47, 57, 67, and 77, without prejudice or disclaimer, and amended claims 1-8, 10-18, 20-28, 30-38, 40-46, 48, 50-56, 58, 60-66, 68, 70-76, 78, and 80. Claim 7 has been amended to correct the informality to which the Examiner objected. In view of these amendments and the remarks that follow, Applicants respectfully traverse the rejections of claims 1-46, 48-56, 58-66, 68-76, and 78-80 under 35 U.S.C. §§ 102(b) and 103(a).

#### **I. Claim Rejections Under 35 U.S.C. § 102(b)**

The rejection of claims 1-6, 11-16, 21-26, 31-36, 41-46, 51-56, 61-66, and 71-76 under 35 U.S.C. § 102(b) is respectfully traversed for the following reasons.

In order to anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), "each and every element as set forth in the claim [must be] found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131, at 2100-70 (8th ed., rev. Feb. 2003) (quoting Verdegaal Bros. v. Union Oil Co. of Cal., 814 F.2d 628, 631 (Fed. Cir. 1987)). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131, at 2100-70 (quoting Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131, at 2100-70.

The Examiner asserted that Templin et al. teaches each and every recitation of claims 1-6, 11-16, 21-26, 31-36, 41-46, 51-56, 61-66, and 71-76. Applicants respectfully disagree.

Templin et al. discloses a gateway used to facilitate transparent connections between trusted and untrusted hosts. See Templin et al., Abstract. The gateway in

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Templin et al. intercepts packets intended for an untrusted host, consumes the packets, and connects to the untrusted host itself; thus keeping the trusted host secure. Id., col. 8, lines 38-47. In turn, when the gateway receives a packet from the untrusted host, it consumes the packet and generates a new packet directed to the trusted host. Id. The packet sent to the trusted host includes the address of the untrusted host; thus the trusted host is “spoofed” into believing it connected directly with the untrusted host while still remaining secure. Id., col. 8, lines 49-54.

Although Templin et al. discloses a transparent intermediary, in some respects the gateway in Templin et al. operates differently than the intermediate entity recited in claims 1-6, 11-16, 21-26, 31-36, 41-46, 51-56, 61-66, and 71-76 . For example, Templin et al. does not teach at least “determining a destination address corresponding to the destination based on the client address,” as recited in amended claims 1, 11, 21, and 31. The gateway in Templin et al. learns the address of the untrusted host (i.e. the destination) by intercepting a packet from the trusted host (i.e. the client) that is directed toward the untrusted host. Templin et al., col. 7, lines 23-28. The addresses of the trusted host and the untrusted host are stored in a control block (Id.), but Templin et al. does not teach that the gateway ever has to determine the address of the untrusted host based on the address of the trusted host.

Templin et al. does mention that the control block entries can be used by the gateway to generate packets to the trusted host that appear to be from the untrusted host. Templin et al., col. 9, lines 4-12. When packets are received from the untrusted host, however, the packets are directed to the gateway, not the trusted host. Id., col. 8, lines 44-47. Therefore, it is possible that the gateway would need to use the control

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block entries to determine the address of the trusted host. Such a situation would never arise regarding the address of the untrusted host because neither the gateway nor the proxy servers within the gateway in Templin et al. ever receive a packet containing only the address of the trusted host. Accordingly, Templin et al. fails to teach at least “determining a destination address corresponding to the destination based on the client address,” as recited in claims 1, 11, 21, and 31.

For at least the foregoing reasons, Templin et al. does not anticipate Applicants’ claims 1, 11, 21, and 31. Accordingly, Applicants request that the rejection of claims 1, 11, 21, and 31 under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Claims 2-6, 12-16, 22-26, and 32-36 depend on claims 1, 11, 21, and 31, respectively. As explained above, claims 1, 11, 21, and 31 are distinguishable from Templin et al. Accordingly, claims 2-6, 12-16, 22-26, and 32-36 are distinguishable from this reference for at least the same reasons given with respect to claims 1, 11, 21, and 31. Applicants therefore request that the rejection of claims 2-6, 12-16, 22-26, and 32-36 under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Furthermore, the Examiner admitted that Templin et al. does not mention the need to send information to an intermediate destination, as recited in cancelled claims 47, 57, 67, and 77. See Office Action ¶ 7, at 5. Claims 41, 51, 61, and 71 have been amended to include the recitations of cancelled claims 47, 57, 67, and 77, respectively. Accordingly, by the Examiner’s own admission, Templin et al. does not teach each and every recitation of amended claims 41, 51, 61, and 71 because the reference does not teach at least “an intermediate communication” with “an intermediate destination address in the destination field,” as recited in amended claims 41, 51, 61, and 71. For

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at least this reason, the rejection of claims 41, 51, 61, and 71 under 35 U.S.C. § 102(b) is improper and Applicants request that the rejection be withdrawn and the claims allowed.

Claims 42-46, 52-56, 62-66, and 72-76 depend on claims 41, 51, 61, and 71, respectively. As explained above, claims 41, 51, 61, and 71 are distinguishable from Templin et al. Accordingly, claims 42-46, 52-56, 62-66, and 72-76 are distinguishable from this reference for at least the same reasons given with respect to claims 41, 51, 61, and 71. Applicants therefore request that the rejection of claims 42-46, 52-56, 62-66, and 72-76 under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

## II. **Claim Rejections Under 35 U.S.C. § 103(a)**

The rejection of claims 7-10, 17-20, 27-30, 37-40, 47-50, 57-60, 67-70, and 77-80 under 35 U.S.C. § 103(a) is respectfully traversed for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” M.P.E.P. § 2143.

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**A. The Rejection of Claims 7, 9-10, 17, 19-20, 27, 29-30, 37, 39-40, 49-50, 59-60, 69-70, and 79-80.**

The Examiner alleged that Templin et al. discloses a manner to transparently proxy between two sources, but conceded that the transparent proxy server disclosed in Templin et al. differs from the transparent proxy server claimed by Applicants. See Office Action ¶ 7, at 5. Specifically, the Examiner admitted that Templin et al. does not mention the need to send information to an intermediate destination, as recited in claims 7, 17, 27, and 37. See Id. The Examiner, however, asserts that Aviani, Jr. et al. makes up for the deficiencies of Templin et al. Applicants disagree.

Aviani, Jr. et al. does not teach or suggest “preparing an intermediate communication having a source field, a destination field, and a temporary field, the preparing including: storing a client address in the source field; storing the destination address in a temporary field; and storing an intermediate destination address in the destination field,” as recited in amended claims 7, 17, 27, and 37. Aviani, Jr. et al. discloses a process of encapsulating packets for transmission to selected network caches by the addition of another TCP/IP header. See Aviani, Jr. et al., col. 5, lines 38-47. This encapsulation of packets, however, is different from the intermediate communication process recited by Applicants.

First, the “intermediate destination” recited by Applicants is not limited to the “network cache” disclosed by Aviani, Jr. et al. Additionally, the header disclosed in Aviani, Jr. et al. does not “stor[e] the destination address in a temporary field,” as recited in claims 7, 17, 27, and 37. The disclosure identified by the Examiner in col. 4, lines 20-31 of Aviani, Jr. et al. mentions storing the destination platform, but this disclosure

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relates to the creation of a bypass list, not the preparation of an “intermediate communication,” as recited by Applicants. Furthermore, the header disclosed in Aviani, Jr. et al. stores the router as the source of the packet. Aviani, Jr. et al., col. 5, lines 40-42. On the contrary, as amended, Applicants’ claims recite “storing a client address in the source field.” Accordingly, neither Templin et al. nor Aviani, Jr. et al., alone or in combination, teach or suggest “preparing an intermediate communication having a source field, a destination field, and a temporary field, the preparing including: storing a client address in the source field; storing the destination address in a temporary field; and storing an intermediate destination address in the destination field,” as recited in amended claims 7, 17, 27, and 37.

Moreover, the Examiner failed to provide a motivation to combine the two references. It is established that “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references.” M.P.E.P. § 2143.01, at 2100-125 (citing AI-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308 (Fed. Cir. 1999)). Furthermore, “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” Id. § 2143.01, at 2100-126 (quoting In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1992)) (emphasis added). There is no such suggestion in Templin et al. Accordingly, the Examiner’s statement that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such a caching system into the proxy server so as to reduce network traffic and minimize the delay of information return” (Office Action ¶ 7, at 5), is insufficient to establish a *prima facie* case of obviousness.

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For at least the foregoing reasons, claims 7, 17, 27, and 37 are patentable over Templin et al. in view of Aviani, Jr. et al. Accordingly, Applicants request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 9-10, 19-20, 29-30, and 39-40 depend upon claims 1, 11, 21, and 31, respectively. As explained above under the 35 U.S.C. § 102(b) analysis, claims 1, 11, 21, and 31 are distinguishable from Templin et al. Accordingly, claims 9-10, 19-20, 29-30, and 39-40 are patentable over Templin et al. for at least the reasons given with respect to claims 1, 11, 21, and 31. Moreover, Aviani, Jr. et al. does not make up for the deficiencies of Templin et al. regarding these claims. Applicants therefore request that the rejection of claims 9-10, 19-20, 29-30, and 39-40 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Cancelled claims 47, 57, 67, and 77 contained recitations similar to those of claims 7, 17, 27, and 37. Claims 41, 51, 61, and 71 have been amended to include the recitations of cancelled claims 47, 57, 67, and 77, respectively. As explained above, claims 7, 17, 27, and 37 are patentable over Templin et al. in view of Aviani, Jr. et al. Accordingly, amended claims 41, 51, 61, and 71 are patentable over Templin et al. in view of Aviani, Jr. et al. for at least the same reasons given with respect to claims 7, 17, 27, and 37. Applicants therefore request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 49-50, 59-60, 69-70, and 79-80 depend upon claims 41, 51, 61, and 71, respectively. As explained above, claims 41, 51, 61, and 71 are patentable over Templin et al. in view of Aviani, Jr. et al. Accordingly, claims 49-50, 59-60, 69-70, and

79-80 are patentable over Templin et al. in view of Aviani, Jr. et al. for at least the reasons given with respect to claims 41, 51, 61, and 71. Applicants therefore request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

**B. The Rejection of Claims 8, 18, 28, 38, 48, 58, 68, and 78.**

As explained above, Templin et al. discloses a gateway used to facilitate transparent connections between two sources. The gateway disclosed in Templin et al., however, differs from the transparent proxy server recited in claims 8, 18, 28, 38, 48, 58, 68, and 78. The Examiner alleged that Aviani, Jr. et al. discloses a manner of transparently proxying between two sources that includes a cache, but conceded that neither Templin et al. nor Aviani, Jr. et al. mention determining whether the client communication is a connection setup request, as recited in claims 8, 18, 28, 38, 48, 58, 68, and 78. See Office Action ¶ 8, at 6. The Examiner, however, alleged that Coile et al. makes up for the deficiencies of Templin et al. and Aviani, Jr. et al. Applicants disagree.

Coile et al. does not teach or suggest at least “storing the address of an intermediate destination in a destination field when the client communication is not a connection setup request,” as recited in claims 8, 18, 28, and 38. Although Coile et al. discloses a method of determining whether the client’s communication is a SYN request, the reference fails to teach or suggest “storing the address of an intermediate destination in a destination field when the client communication is not a connection setup request.” Instead, Coile et al. mentions relaying information requests (i.e. non-connection setup requests) to a server. Colie et al., col. 3, lines 27-29. This relay of

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information requests, however, does not include “storing the address of an intermediate destination” for any type of client communication.

Further, the alleged “caching system” in Coile et al., referenced by the Examiner, discloses only the possibility of using a Private Internet Exchange (PIX) to perform client authentication for networks served by the PIX. It does not “stor[e] the address of an intermediate destination,” nor does it perform any function “when a client communication is not a connection setup request.” Accordingly, neither Templin et al., Aviani, Jr. et al., nor Coile et al., alone or in combination, teach or suggest at least “storing the address of an intermediate destination in a destination field when the client communication is not a connection setup request,” as recited in claims 8, 18, 28, and 38.

Moreover, the Examiner failed to provide a motivation to combine these references. The Examiner merely alleged that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such a setup recognition into a transparent proxy server with caching system so as to properly handle the initial connection setup that occurs between two nodes in a TCP/IP based packet system.” Office Action ¶ 8, at 6-7. For the same reasons given above with respect to claims 1, 11, 21, 31, 41, 51, 61, and 71, such a statement is insufficient to establish a *prima facie* case of obviousness because “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references.” M.P.E.P. § 2143.01, at 2100-125 (citing Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308 (Fed. Cir. 1999)).

For at least the foregoing reasons, claims 8, 18, 28, and 38 are patentable over Templin et al., in view of Aviani, Jr. et al., and further in view of Coile et al. Accordingly,

Applicants request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 48, 58, 68, and 78 contain recitations similar to those of claims 8, 18, 28, and 38; namely, “storing the intermediate entity address in a destination field in response to a determination that the client communication is not a connection setup request.” As explained above, claims 8, 18, 28, and 38 are patentable over Templin et al., in view of Aviani, Jr. et al., and further in view of Coile et al. Accordingly, claims 48, 58, 68, and 78 are patentable over Templin et al., in view of Aviani, Jr. et al., and further in view of Coile et al. for at least the same reasons given with respect to claims 8, 18, 28, and 38. Applicants therefore request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

### **III. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

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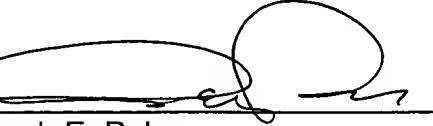
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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: December 5, 2003

By: 

Joseph E. Palys  
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**Attachments: Replacement Sheet 1 - Figure 13**

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